UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ALIVECOR, INC.,
Patent Owner.

IPR2021-00972
Patent 10,638,941

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE PETITIONER'S EVIDENCE

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I. INTRODUCTION

Petitioner Apple Inc. ("Apple") respectfully requests that the Board deny the Patent Owner AliveCor Inc.'s ("AliveCor") motion to exclude Exhibits APPLE-1060-68 and APPLE-1072-85 (Paper No. 34), and decide the patentability of the claims at issue on the full record presented to the Board. As set forth below, each of the complained-of exhibits was submitted to the Board in compliance with PTAB rules and the Rules of Evidence.

II. ARGUMENT

A. Dr. Stultz's Prior Testimony at the ITC Is Admissible

AliveCor first asks this Board to exclude prior testimony from an expert who testified before the ITC on behalf of Apple—Dr. Stultz. According to AliveCor, Dr. Stultz's testimony is hearsay and should be excluded, because—despite never actually asking to take his deposition after his expert report and other testimony was properly submitted in compliance with 37 CFR § 42.53, and despite the fact that AliveCor both deposed and cross-examined Dr. Stultz about his opinions at the ITC—Dr. Stultz was not deposed again in the present proceeding.

As the Board has previously recognized, this is exactly the type of argument that puts form over substance to an absurd degree. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01255, Paper 79 at 77 (PTAB Jan. 26, 2021) (finding "limited merit" to such a contention). Indeed, the Board has previously noted that, even though a declaration may have previously been filed in another matter and

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may bear a different caption, the difference in caption "is artificial" if (as here) the declaration was also "filed in this proceeding, as if they were prepared for this matter." *Apple Inc. v. Virnetx Inc.*, IPR2016-00332, Paper 29 at 80-81 (PTAB June 22, 2017).[1] This is particularly true where, as here, the "Patent Owner could have sought to cross-examine" Dr. Stultz, but didn't, *id.*; or where the Patent Owner could have cited portions of its previous deposition and cross-examination of Dr. Stultz from the ITC proceeding. This Board should not allow AliveCor to make an apparent strategic choice to sit on its hands regarding Dr. Stultz's deposition, manufacture its own evidentiary issues, and then point to those supposed evidentiary issues as a reason for exclusion.[2] Thus, Dr. Stultz's prior

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[1] *See also* 37 CFR § 42.53(b)(1)("[u]ncompelled direct testimony may be taken at any time to support a petition, motion, opposition, or reply"); 37 CFR § 42.2 (broadly defining the form for uncompelled direct testimony – "*Affidavit* means affidavit or declaration under § 1.68 of this chapter. A transcript of an *ex parte* deposition or a declaration under 28 U.S.C. 1746 may be used as an affidavit.")

[2] These facts alone distinguish the cases cited by AliveCor, where there was no showing that the proponent of the evidence had the ability to make witnesses available for deposition. *See, e.g., Captioncall, LLC v. Ultratec, Inc.*, IPR2015-

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testimony is admissible under 37 CFR § 42.53.

In any event, AliveCor also misses the mark as to the form they seek to put above substance. Dr. Stultz's testimony is plainly admissible at least pursuant to FRE 804(b)(1) for exactly the same reasons that the Board considers any testimony offered by an expert in the form of an expert declaration or a deposition.

This Board routinely and properly considers statements that are technically "hearsay" from experts, both in the form of declarations and deposition testimony. Per the rules of evidence, "hearsay" is a statement which (1) "the declarant does not make while testifying ***at the current trial or hearing***;" and (2) "a party offers in evidence to prove the truth of the matter asserted in the statement." Fed. R. Evid. 801(c). So, for example, despite the fact that statements made in an expert declaration are not statements made "while testifying at the current … hearing," the Board nonetheless considers these statements because the Board doesn't allow for live testimony at an IPR hearing (thus all experts are "unavailable" to testify at the hearing because no legal process can procure their attendance) and because the Board's rules provide for the opportunity to depose them. *See* Fed. R. Evid. 804(a)(5)(A) (unavailability); Fed. R. Evid. 804(b)(1) (prior testimony).

00637, Paper 98 at 11 (denying Patent Owner's attempt to introduce testimony from employees of Petitioner where it made no attempt to subpoena them).

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The Federal Rules of Evidence draw no distinction between prior testimony offered in the same proceeding or another one. *See, e.g.,* Fed. R. Evid. 804(b)(1) (applies to sworn testimony, "***whether given during the current proceeding or a different one***"). This Board should not draw one either. The key question isn't whether the testimony was offered in this proceeding, but rather whether (as the Rules of Evidence set forth) AliveCor had the opportunity and a similar motive to cross-examine the statements. Here, there can be no question that AliveCor did. AliveCor does not, and cannot, dispute, that Dr. Stultz offered testimony on validity, and in particular regarding a POSITA's knowledge and understanding of machine learning, in the ITC; that AliveCor both deposed and cross-examined Dr. Stultz in that proceeding on those issues; and that AliveCor had the opportunity (which it didn't pursue) to depose Dr. Stultz again in this IPR. Thus, Dr. Stultz's prior testimony is admissible under Fed. R. Evid. 804(b)(1). *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01255, Paper 79 at 77 (PTAB Jan. 26, 2021) ("Exhibit 1071 is Dr. Auth's ITC trial testimony. Patent Owner argues that Exhibit 1071 is inadmissible hearsay" and "Petitioner argues that Exhibit 1071 … is admissible under FRE 804(b)(1);" "We find limited merit in Patent Owner's Motion to Exclude"); *CostCo Wholesale Corp. v. Robert Bosch LLC*, IPR2016-00038, Paper 68 at 10 (PTAB Mar. 30, 2017) ("Mr. Merkel's former trial testimony is admissible under Federal Rule of Evidence 804(b)(1)").

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